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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,211	12/16/2003	Andreas Junghans	tesa 1621-WCG	7667

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EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/737,211	Applicant(s) JUNGHANS ET AL.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/03&02/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann et al. (US Patent 5,897,949) in view of Horiki et al. (US Patent 4,868,045).
2. Luhmann et al. teach an adhesive tape which can be redetached by pulling, without residue and without damage, having a foam backing coated on one or the both sides with a self-adhesive composition (see Abstract). The self-adhesive tape can be used in labels, signs, for joining materials which are to be parted at later point in time, sealing elements etc. (Column 3, lines 45-58). The self-adhesive tape contains block copolymers (Column 3, lines 60-61) and tackifiers (Column 4, line 16).
3. Luhmann et al. are silent with respect to teaching a water-soluble polymer as claimed in the claim 1, amount of water-soluble polymer as claimed in claims 2 and 3, and water-soluble polymers as claimed in the claim 4.
4. Horiki et al. teach a masking member that can be used to protect a surface. The masking member consists of an emulsion type adhesive coated onto a closed cell polystyrene foam (Abstract). Horiki et al. teach that it is necessary to prevent the adhesive layer from transferring from the masking member to a surface, which is to be protected (Column 1, lines 26-28). The adhesive of Horiki et al. contains a water-

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soluble polymer in the amount of about 0.1 to 20% by weight of the weight of the adhesive emulsion, which may increase the cohesive force of the adhesive and gives a releasing property to the adhesive (Column 1, lines 60-65). Additionally, the water-soluble polymer does not deteriorate stickiness and weatherability of the adhesive (Column 1, line 69).

5. Horiki et al. disclose that the use of a water-soluble polymer in more than 20% weight percent can cause the decrease in the stickiness of the adhesive (Column 3, lines 3-9). The water-soluble polymers used in the adhesive emulsion are polyvinyl alcohol, polyacrylamides, and polyvinyl pyrrolidone (Column 2, lines 60-68, Column 3, lines 1-2).

6. Regarding the claims 1-4, it would have been obvious for a skilled artisan to add a water-soluble polymer in the amount disclosed in the invention of Horiki et al. in the adhesive of Luhmann et al., motivated by the desire to improve the cohesive force and weatherability of the adhesive.

7. Regarding the claims 5 and 6, in addition to above disclosed matters of Luhmann et al., the pressure sensitive adhesive of Luhmann et al. contains plasticizers, light stabilizers, antioxidants, and fillers such as silica, glass, alumina, zinc oxides, calcium carbonate, titanium dioxides, and carbon black (Column 4, lines 31-39).

8. Regarding the claims 7, please see the previously disclosed invention of Luhmann et al.

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Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/739,705. The scope of the claims 1-7 examined in this office action is same as the scope of the claims 1-7 of copending application 10/739,705. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

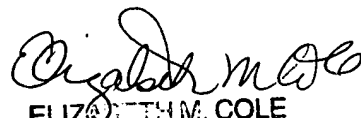
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD


ELIZABETH M. COLE
PRIMARY EXAMINER